

**Remarks:**

The claims are indicated as "Original" in that there have no amendments of language. The brackets and letter "c" present before in the text that was filed have been removed so that the claims accord with what has been published by the Office.

This Response is accompanied by a Declaration under Rule 131 which asserts inventive activity prior to the earliest date of the published patent application of Chen et al, 2003/0046542, which was the principal reference on which the Examiner relied in rejecting the claims presented originally and in this Response. Thus it is respectfully submitted that the rejection previously made cannot stand and must be withdrawn.

Notwithstanding the inapplicability of the Chen et al published application at this time, it is respectfully submitted that the prior rejection of claims as obvious under 35 USC 103 is inappropriate and should be withdrawn.

The Examiner helpfully references specific passages in both the Chen et al disclosure and the disclosure of the secondary reference, Gray U.S. 6,087,955 Paragraph 0034 in Chen et al and Column 4, lines 44 through 52 in Gray). What these passages make clear is that neither Chen et al nor Gray, taken alone or in any combination, teaches what applicants here claim. Referring now to the claims presented here, applicants claim "second input device selectively interposed between said first input device and said security element ". Both Chen et al and Gray teach that the second input device is never connected between what the Examiner deems equivalent to the first input device and the security device.

Paragraph 0034 of Chen et al refers to Figure 2 of that disclosure. As there shown, and as conceded by the Examiner, the smart card reader 12 (the second input device in the Examiner's reading) is connected to the trusted device 24 (the security element in the Examiner's reading) through an I/O device 23 which also connects the keyboard (the first input device in the Examiner's reading). The two input devices appear to be connected in parallel, not serially. Further, there is no teaching of selective interposition. The referenced portion of the Gray teaching, in

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Column 4, refers to elements shown in Figures 1 and 2 of that patent. There, the card reader 68 (the second input device in the Examiner's reading) is connected to the processor 60 (which must be the security element in the Examiner's reading, although not so identified specifically) in parallel with the keyboard 16 (the first input device in the Examiner's reading). Thus, as in Chen et al, the two input devices appear to be connected in parallel, not serially. Further, there is no teaching of selective interposition. The rejection under 35 USC 103 is simply inapposite.

The Graham v Deere test for obviousness under 35 USC 103 is the subject matter of Section 2141 et seq in the Manual of Patent Examining Procedure. To briefly restate, the three inquiries set forth by the Court, in order, are to determine the applicable prior art, then determine the differences between that art and the claimed invention, and then determine whether a person of ordinary skill in the applicable art would know to make the modification necessary to arrive at those differences in view of the prior art applied.

As has been stated by the Court of Appeals for the Federal Circuit in considering matters on appeal from the Board of Appeals within the Patent Office, obviousness is a question of law (the Court citing Graham v Deere), but this determination occurs in the context of a factual inquiry regarding the scope and content of the prior art. This factual inquiry examines what a reference would have taught or suggested to one of ordinary skill in the art at the time the of the invention (the Court citing Northern Telecom v Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321). The Court has cautioned against focusing on the obviousness of the differences between the claimed invention and the prior art rather than the obviousness of the claimed invention as a whole as 35 USC 103 requires (citing Hybritech, Inc. v Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81) and against the use of hindsight reconstruction of what is disclosed in a prior art reference (citing Grain Processing Corp. v American Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788). The Court has quoted approvingly from its decision in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, in which it said:

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The mere fact that the prior art may [emphasis added] be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

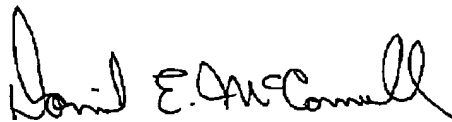
On the latter point, the CAFC has said that the Patent Office, in determining the obviousness of a claimed invention that combines known elements, must determine whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination (citing Lindemann Maschinenfabrik GmbH v American Hoist and Derrick Co., 730 F.2d 1452, 221 USPQ 481).

It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. See In re Sernacker, 702 F.2d 989, 995; 217 USPQ 1, 6 (Fed. Cir. 1983). The reviewing court for the Patent Office requires proof by evidence in order to establish a *prima facie* case when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. See In re Knapp-Monarch Co., 296 F.2d 230, 232; 132 USPQ 6, 8 (CCPA 1961) and In re Cofer, 354 F.2d 664, 668; 148 USPQ 268, 271-272 (CCPA 1966). See also Section 2143 et seq of the MPEP.

Here, that burden has not been met.

For the reasons given, reconsideration and allowance are respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel E. McConnell". The signature is fluid and cursive, with the first name "Daniel" written in a larger, more prominent script than the last name "McConnell".

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